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EXAMINER

LIN, JAMES

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Box 3(a):

The newly added limitations in claims 28-30 of the Ag/binder volume ratio being 1/3 or higher, 1/2 or higher, and 1/1 or higher raises new issues. The newly added limitation in claim 31 of wherein the light-transmitting electromagnetic wave-shielding film has an aperture ratio of 85% or higher raises new issues. Further search and/or consideration would be required for these newly added limitations.

Box 3(d):

Claims 27-31 are newly added, but Applicants have not cancelled a corresponding number of finally rejected claims.

Box 11:

Applicant argues on pg. 10 that one of ordinary skill in the art would have had no reason to combine the teachings of Marutsuka and Takaoka. However, Marutsuka teaches a method of forming a patterned metal film used as a transparent electromagnetic radiation film. Takaoka teaches a method of forming a patterned metal film having transparency. One of ordinary skill in the art would have recognized that the substitution of one method for the other would have yielded a similar film and would have made the substitution with predictable results.

Applicant argues on pg. 10 that one of ordinary skill in the art would have had no reason to replace the method of Marutsuka with the method of Deng. However, Deng also teaches a method of forming a patterned metal film having transparency. One of ordinary skill in the art would have recognized that the substitution of one method for the other would have yielded a similar film and would have made the substitution with predictable results.

Applicant argues on pg. 11 that the Ag/binder volume ratio is 1/4.49 according to Applicant's calculations of the Ag/binder ratio of Takaoka. However, Applicant does not give the basis of the calculation and seems to be only calculating the Ag/binder ratio in the Example of Takaoka. Takaoka also exemplifies a broader range, wherein the silver halide can be present in the amount of 10-90 wt%. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments (In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971)). A reference may be relied upon for all that it would have

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reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998). On a basis of 90 wt% silver halide and 10 wt% binder, the Ag/binder volume ratio would be 1/2.

Applicant argues that the results set forth in working Example 2 of the present specification show that the process according to Takaoka is excluded from the recitation that “the light transmitting portion does not substantially have physical development nuclei”. However, Applicant does not address either 1) the fact that Takaoka teaches formation of the development nuclei only where the silver is to be formed or 2) the rejection in view of Deng.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy Lin whose telephone number is (571)272-8902. The examiner can normally be reached on Monday thru Friday 8AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jimmy Lin/
Examiner, Art Unit 1792

/Timothy H Meeks/
Supervisory Patent Examiner, Art Unit

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